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09/536,137	03/28/2000	Daniel A. Benton	FA0881 US Na	5926

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EXAMINER

NGUYEN, CAM LINH T

ART UNIT PAPER NUMBER

2161

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/536,137	Applicant(s) BENTON ET AL.	
	Examiner CamLinh Nguyen	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is response to the RCE filed 10/11/2005.
2. Applicant's arguments about declaration und 1.131 are acknowledged. Claims 1 – 13 are currently pending for further processing.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corrigan et al (U.S. 6,522,977).

◆ As per claims 1, 3, 11,

- “Gathering the VIN (vehicle identification number) and manufacturer’s paint code, and manufacture date” See Fig. 1, element 10, col. 5 line 4 – 13. The paint code corresponds to the “OEM code numbers” which is the manufacturer’s designated colors, and may be obtained from a manufacturer (col. 8 line 61 – col. 9 line 10). Corrigan teaches that any additional information or vehicle specific designation of the vehicle could be used to the VIN system (col. 4 line 7 – 12, 39 – 44). Therefore, the manufacturer’s paint code may be obtained in step 10 in the invention.

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- “Extracting from the VIN the model year and manufacturing site information” See col. 4 line 21 – 34, col. 8 line 60 - 66.
- “Searching database” See col. 8 line 60 - 66
- “Identifying the refinish colorcoat” See Fig. 1, col. 8 line 60 – col. 9 line 64.

Corrigan discloses a method that requires both VIN number and scanning sample color in order to obtain an accurate color matching. However, it is possible for one with skill in the art at the time the invention was made to practice different way, such as eliminating the step of scanning the sample color, for some reasons: the result would be the same without scanning sample color because the VIN number fully provides the color matching; the eliminated step would reduce the cost of the painting job.

◆ As per claims 2, 4, 9-10, 12, Corrigan discloses:

- “ A computer acting under a program” See col. 6 line 3 - 22, col. 9 line 65 – 67.

◆ As per claims 5, 7, Corrigan discloses:

- “Inputting the vehicle VIN” See Fig. 1, element 10, col. 5 line 4 – 13. The paint code corresponds to the “OEM code numbers” which is the manufacturer’s designated colors, and may be obtained from a manufacturer (col. 8 line 61 – col. 9 line 10). Corrigan teaches that any additional information or vehicle specific designation of the vehicle could be used to the VIN system (col. 4 line 7 – 12, 39 – 44). Therefore, the manufacturer’s paint code may be obtained in step 10 in the invention.
- “Inputting the manufacturer’s paint code” The paint code corresponds to the “OEM code numbers” which is the manufacturer’s designated colors, and may be obtained from a manufacturer (col. 8 line 61 – col. 9 line 10). Corrigan teaches that any additional

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information or vehicle specific designation such as paint formulations (col. 7 line 66 – 67) of the vehicle could be used to the VIN system (col. 4 line 7 – 12, 39 – 44).

Therefore, the manufacturer's paint code may be obtained in step 10 in the invention.

- "Processing the input data" See col. 4 line 21 – 34, col. 8 line 60 - 66.
- "Executing a search for a refinish colorcoat" See col. 8 line 60 - 66
- "Displaying in human-readable" See col. 5 line 38 – 40, col. 11 line 47 – 50.

♦ As per claims 6, 8, Corrigan discloses:

- "Preparing an actual refinish colorcoat" See col. 11 line 59 - 64.
- "Applying the prepared refinish colorcoat" See col. 11 line 59 - 64.

♦ As per claim 13, Corrigan discloses:

- "The model year and site of manufacture are ascertained from the VIN" See col. 4 line 21 - 34.

5. Claims 1 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yauk et al (U.S. 5,153,825) in view of the Cars & Parts Magazine, the "Catalog of Thunderbird ID Numbers 1955-93", Copyright 1994 by Amos Press Inc., pages 217 – 218.

♦ As per claims 1, 3, 11, 13,

Yauk discloses a method for storing, retrieving, and displaying the information of a vehicle, comprising:

- "Gathering the VIN (vehicle identification number) and manufacturer's paint code, and manufacture date" see Fig. 11 of Yauk. Yauk teaches that the user can edit information that is input into the system in sections 260 (col. 13, lines 7 – 8 of Yauk). As seen in Fig.

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11, section 260 includes the car type, year, which are information from the VIN number.

Fig. 11 – 12A discloses a pain code which is original equipment manufacturers (Fig. 12A, field 312, col. 16, lines 4 – 12 of Yauk).

Yauk does not clearly teach that the manufacture of the vehicle is obtained. However, the Thunderbird catalog, on the other hand, discloses that the VIN number include year of the vehicle, model, manufacture. That information is located on a metal tab that is attached to the top of the instrument panel and visible through the windshield (see page 217 of the catalog). The Thunderbird catalog also discloses information about the pain code and other information located to the left front door lock face panel or door pillar (see page 217 of the catalog).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the system of Yauk by gather the VIN information and the color data (as taught by Thunderbird catalog) and store it in the database of Yauk for later retrieval matching paint color, because the combination would provide more accuracy result than just the VIN its self.

♦ As per claim 2, 4, 9-10, 12, the combination of Yauk and the Thunderbird catalog disclose:

- “A computer acting under a program” See Fig. 2, col. 8, lines 33 – 65 of Yauk.

♦ As per claim 5, 7, the combination of Yauk and the Thunderbird catalog disclose:

- “Inputting the vehicle VIN” See Fig. 2, col. 8, lines 33 – 65 of Yauk.

♦ As per claims 6, 8, the combination of Yauk and the Thunderbird catalog disclose:

- “Preparing an actual refinish colorcoat” See Fig. 1 of Yauk.

Response to Arguments

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6. Applicant's arguments filed 10/11/2005 have been fully considered but they are not persuasive based on new ground of rejection and the following response.

Affidavit or Declaration Under 37 CFR 1.131

The declaration under 37 CFR 1.131 filed October 11, 2005 is insufficient to overcome the rejection of claims 1 - 13 under 35 USC 103(a) as being unpatentable over Corrigan et al (U.S. 6,522,977) as set forth in the last Office action 4/14/2005 because: it does not establish conception and does not show diligence for the appropriate period. The evidence submitted is not adequate to establish prior invention. It does not establish conception or reduction to practice prior to the date of the Dutta reference and does not show diligence for the appropriate period (see MPEP 715.07).

CONCEPTION:

1. It appears that applicant is relying on the date prior December 17, 1999 disclosure statement to prove conception.

“Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.” (see MPEP 715.07).

“A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm’r Pat. 1883). Similarly, a declaration by the inventor to the effect that his

or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.” (See MPEP 715.07).

“The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”)” (See MPEP 715.07).

2. In the affidavit in paragraphs 1 - 5, applicant merely refers to the flowchart as an evidence of conception. No explanation of how the flowchart supports conception of the claimed invention is provided. This amounts to a general allegation and does not meet applicant’s burden of clearly explaining the exhibit “pointing out exactly what facts are established and relied upon by applicant”.
3. The examiner has reviewed the flowchart and does not see how it would support conception. For example, the Examiner does not see the flowchart provided by Applicant would

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allow one of ordinary skill in the art to practice or make use of the invention nor how the flowchart relates to the claim language. This particular example is merely for illustration and is not comprehensive. Applicant bears the burden of establishing prior invention.

DILIGENCE:

“In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958) (MPEP 715-07(a)).

4. Applicant has not established conception. However, in the interest of compact prosecution the examiner will address the affidavit with respect to diligence. Note that this is for guidance and is not necessarily comprehensive.

“The critical period in which diligence must be shown begins just prior to the effective date of the reference (12/17/1999) or activity and ends with the date of a reduction to practice (3/28/2000), either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. (See MPEP 715.07 (a))”.

“The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975)”

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“Diligence requires that applicants must be specific as to dates and facts; Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949)”

“An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.)”

5. In paragraph 7, Applicant states “an employee of Dupont’s Performance Coating Group, Refinish Division corresponded with the Dupont attorney to identify the inventors (and others working with them) on December 20, 1999.” In paragraph 8, “an employee of Dupont’s Performance Coating Group, Refinish Division inquired to the Dupont attorney as to the status of the patent application on January 19,2000”. And in paragraph 9, “ the Dupont attorney responded two days later on January 21, 2000”.

This is a mere general allegation of diligence. There are no specific acts indicates alleged during the periods of December 19, 1999 to January 21, 2000. Applicant does not meet the standard for proving diligence.

6. In paragraph 15, Applicant states “I received a copy of the final patent application covering the Claimed Invention, reviewed it, then signed the formal documents on March 10, 2000”, and in paragraph 16, “ The application was filed in the United States Patent and Trademark Office on March 28, 2000”. This is also a mere general allegation of diligence. There are no specific acts indicates alleged during the periods of 3/10/2000 – 3/28/2000. Applicant therefore, does not meet the standard for proving diligence.

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is (571) 272-4024.

The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571 – 273 – 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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FRANTZ COBY
PRIMARY EXAMINER